

### **REMARKS**

Applicants thank the Examiner for agreeing to examine new claims 41-42 along with the elected claims 19-20 and 36. Applicants also thank the Examiner for reconsidering and withdrawing the previous 102(b) and 103 rejections of claims 19-20 and 36 over Nishino.

### **The Pending Claims**

Claim 19, claims 20 and 36 that depend from claim 19, and claims 41-42 are pending in this application. Claims 21-35 and 37-40 are withdrawn.

### **Rejections**

#### **35 U.S.C. §103(a) – Obviousness**

Claims 19-20, 36 and 41-42 stand rejected under 35 U.S.C. §103(a) as allegedly obvious over Amschler et al., U.S. Patent 5,712,298 ("the '298 patent"). Specifically, the Examiner asserts that the '298 patent recites structurally similar compounds and compositions to those recited in the pending claims. The Examiner acknowledges that the '298 patent has not made any of the claimed compounds. Nevertheless, the Examiner asserts that it would have been obvious to one of ordinary skill in the art to obtain the claimed compounds within the generic disclosure of the '298 patent because of their alleged structural similarities. Applicants traverse.

The Examiner has failed to consider the pharmaceutical activity of the claimed compositions. The Technical Field of the Invention teaches that the claimed pharmaceutical compositions may be advantageously used as therapeutic agents for *inosine-5'*-

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*monophosphate dehydrogenase (IMPDH) mediated processes* (page 1, lines 9-12).

Specifically, the application discloses that the claimed pharmaceutically acceptable compositions are useful as IMPDH inhibitors and can be used for the treatment or prophylaxis of transplant rejection and autoimmune disease (page 6, lines 5-11).

By contrast, the '298 patent refers to its compounds and compositions as PDE inhibitors (the '968 patent, col. 1, lines 60-63). Thus, there is absolutely no suggestion in the '298 patent that its specific compositions, let alone compositions "structurally similar" to specific compounds of the '298 patent, could be used as therapeutic agents for IMPDH-related diseases. Indeed, the skilled worker would not even consider modifying the compounds or compositions referred to in the '298 patent to produce the compositions of the pending claims because there is no suggestion that such modifications would provide the IMPDH inhibitors of the pending claims. Thus, on the facts alone, the objection fails.

The Examiner's reliance on "structural similarity" is also at odds with the law. It is well established that, "[f]rom the standpoint of patent law, a compound and all of its properties are inseparable; they are one and the same thing." (In re Papesch, 315 F.2d 381, 391 (CCPA 1963)). Therefore, structural modification of one compound or composition into another is unobvious when the modified compound or composition has an unknown pharmacologically advantageous property.

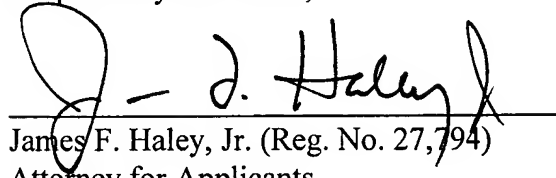
For these reasons, applicants respectfully request that the Examiner reconsider and withdraw the obviousness rejection.

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CONCLUSION

Applicants request that the Examiner consider the above remarks, withdraw the outstanding rejections, and allow the amended claims to issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. F. Haley, Jr.", is written over a horizontal line.

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